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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,078	06/22/2000	H. Brock Kolls	USE-5434US2	8864

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EXAMINER
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PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/599,078

Applicant(s)

KOLLS, H. BROCK

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52,53,61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-53 and 61 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3624

**DETAILED ACTION**

1. This communication is in response to amendment filed 6/24/03.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/03 has been entered.

***Response to Amendment***

3. Claim 52 has been amended per request. Currently, claims 52-53 and 61-62 are pending and have been examined.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3624

5. Claims 52-53 and 61-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. Claim 52 recites limitations regarding a method for altering the value of a user's phone card. However, the specification, fails to make any distinction between the smart card and the phone card. A phone card is a prepaid card, which can be used to make telephone calls. The card contains a preset long distance phone time. Time is deducted off the card as its being used. The specification fails to teach how the "phone card" of the claimed invention is distinct, in terms of the claimed features that facilitate funds transfer in order to increase the value of the phone card.

Dependent claims also inherit this deficiency.

#### ***Response to Arguments***

7. In the previous office action (Final rejection mailed 12/16/02, specific defects of claim 52 leading to 112 (second) rejections were indicated. However, the amendment of claim 52

Art Unit: 3624

has not resolved all defects as explained in the following paragraphs.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 52 and 61-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following analysis applicable to claim 52 also applies to dependent claims 53, 61 and 62.

10. The claimed invention contains the following deficiencies which render it indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) step b) retrieving a plurality of transaction data does not positively relate to step a) detecting whether a phone card has been inserted or swiped.. the retrieving step should be recited as being responsive to the detecting step.

Art Unit: 3624

(2) step c) fails to provide relationship of the transaction data communicated to the universal server and "user identification information", "at least one user account from said electronic commerce terminal". This relationship essential to retrieving of the user identification based on a dynamic identification interchange.. as further claimed in step c).

(3) step d) is not related to any other step of claim.

(4) step g) of the claim recite transferring funds either i) between at least user account or ii) between said at least one use account and said phone card .. based on said dynamic identification interchange within said universal server.

In this limitation it vague and unclear as to how funds transfer between "said at least one user account" is to occur. Funds only transfers to one account to one or more other accounts. Therefore, limitation g) part i) is not properly recited.

(5) Since the accounts are held by the user at locations (banking, credit accounts, or other databases as per disclosure) remote from the card reader device, steps including communication of account information and the funds transfer

Art Unit: 3624

request must be positively recited to facilitate the funds transfer step g).

(6) Claim 52 is also rendered indefinite because step "dynamic identification interchange (DII)" as disclosed (p. 38 L30 - p. 39 L8, reproduced below) require a first form of ID and a second form of ID be input or stored and correlated in order that the functionality of DII be enabled. Refer to 112(first) analysis and the following teaching of the disclosure:

"..Said transaction "swap data step, append data step, convert data step, route data step, and/or process data step" processing is referred to as a dynamic identification interchange (DII). The DII process accepts a first identification form/transaction form and substitutes the first form for a second form. For example, a hotel room key/card may be accepted as a first form of ID and in a DII processing step substituted for or appended to a second form of ID, a credit card. This process can allow a user to have goods and services billed to a credit card by being identified first with a hotel room key/card. Processing then moves to block 910. "

Since the claimed invention fails to identify the first form and the second form of ID associated with the "plurality of transaction data" retrieved from a phone card reader, the DII lacks sufficient data to process the transaction data.

Based on the foregoing analysis and deficiencies discussed, the recited claims are rendered indefinite for failing to

Art Unit: 3624

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

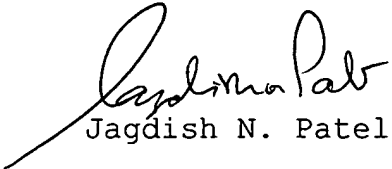
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

9/1/03